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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,015	07/20/2001	Kazuhiro Sugawara	35.C15592	9096
5514	7590	06/07/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			DELGADO, MICHAEL A	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/909,015	SUGAWARA, KAZUHIRO
	Examiner	Art Unit
	Michael S. A. Delgado	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 April 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23, 26-34, 37-48 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 23, 26-34, 37-48 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 20 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/14/06</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 23, 26-34, 37-48 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No 6,073,142 by Geiger et al.

In claim 23, Geiger teaches about a communication apparatus, which is connected to an E-mail server via a network, said communication apparatus comprising (Fig 1,102):
a receiving unit (Fig 3, 282), adapted to receive an E-mail which is to be sent to said communication apparatus stored in a mailbox provided on an E-mail server (Col 11, lines 1-10);
a first obtaining unit (Fig 2, 200), adapted to obtain attribute information of the E-mail stored in the mailbox (Col 3, lines 40-50) (Col 6, lines 20-25) (Col 6, lines 50-60) (Col 10, lines 30-40);
a discriminating unit (Fig 2, 210), adapted to discriminate whether or not to receive the E-mail before said receiving unit receives the E-mail based on the attribute information obtained by said first obtaining unit (Col 10, lines 30-40);

Art Unit: 2144

in a case where said discriminating unit discriminated to receive the E-mail, said receiving unit receives the E-mail that said discriminating unit discriminated to receive (Col 7, lines 1-10); and

a controlling unit (Fig 2, 230), adapted to, in a case where said discriminating unit discriminated not to receive the Email, send to the E-mail server an instruction for deleting from the mail box the E-mail that said discriminating unit discriminated not to receive (Fig 4,422) (Col 10, lines 50-55),

wherein, in a case where a plurality of E-mails are stored in the mail box, after said controlling unit sends to said E-mail server an instruction for deleting the Email that said discriminating unit discriminated not to receive, or after said receiving unit receives the E-mail that said discriminating unit discriminated to receive, said discriminating unit further discriminates whether or not to receive an E-mail other than the E-mail that said discriminating unit discriminated not to receive (Col 7, lines 1-15).

In claim 26, Geiger teaches about a communication apparatus according to Claim 23, wherein said first obtaining unit obtains size information of the E-mail as the attribute information, and said discriminating unit discriminates whether or not to receive the E-mail based on the obtained size information (Col 3, lines 40-50) (Col 10, lines 30-40).

In claim 27, Geiger teaches about a communication apparatus according to Claim 26, further comprising a second obtaining unit, adapted to obtain maximum value information of a size of the E-mail capable of being received by said receiving unit (Col 3, lines 40-50),

wherein said discriminating unit discriminates whether or not to receive the E-mail by comparing the size information of the E-mail obtained by said first obtaining unit with the maximum value information obtained by said second obtaining unit (Col 3, lines 40-50) (Col 10, lines 30-40).

In claim 28, Geiger teaches about a communication apparatus according to Claim 23, wherein said controlling unit receives only header information of the E-mail that said discriminating unit discriminates not to receive, and stores, as communication history information, information obtained from the received header information (Col 3, lines 40-50) (Col 17, lines 15-25) (Col 23, lines 1-5). Discrimination that is made base on sender is extracted from the source address of the header.

In claim 29, Geiger teaches about a communication apparatus according to Claim 26, wherein said controlling unit stores as communication history information the size information of the E-mail that said discriminating unit discriminates not to receive (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-5).

In claim 30, Geiger teaches about a communication apparatus according to Claim 23, wherein said controlling unit stores as communication history information a fact that the reception by said receiving unit to the E-mail that said discriminating unit discriminates not to receive is stopped (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-5).

In claim 31, Geiger teaches about a communication apparatus according to Claim 23, wherein said controlling unit stores as communication history information a fact that the E-mail that said discriminating unit discriminates not to receive is deleted (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-5).

In claim 32, Geiger teaches about a communication apparatus according to Claim 23, wherein, in a case where said receiving unit receives the E-mail that said discriminating unit discriminates to receive, said controlling unit stores as communication history information the information obtained from the E-mail received by said receiving unit (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-5).

In claim 33, Geiger teaches about a communication apparatus according to Claim 23, further comprising an output unit, adapted to, in a case where said receiving unit receives the E-mail that said discriminating unit discriminates to receive, output the E-mail received by said receiving unit (Col 10, lines 50-55).

Claims 34 and 37-44 are the methods to the apparatus of claims 23-33 respectively and are rejected for the same reason as claims 23-33.

Claim 45 is the program for causing a computer to execute the apparatus of claim 1 is rejected for the same reason as claim 1.

Claim 46 is the computer-readable storage medium which stores a program used by a computer to execute the method of the apparatus of claim 1 is rejected for the same reason as claim 1.

In claim 47, Geiger teaches about a communication apparatus according to Claim 23, wherein, said controlling unit sends to said E-mail server an instruction for deleting from the mail box the E-mail that said discriminating unit discriminated to receive (i.e. forwarding), after said receiving unit receives the E-mail that said discriminating unit discriminated to receive (Col 10, lines 50-60).

In claim 48, Geiger teaches about a communication method according to Claim 34, wherein, said controlling step includes sending to said E-mail server an instruction for deleting from the mail box the E-mail that said discriminating step discriminated to receive (i.e. forwarding), after the Email that said discriminating unit discriminated to receive is received in said receiving step (Col 10, lines 50-60).

Response to Arguments

Applicant's arguments include the failure of previously applied art to expressly disclose deleting a unwanted message prior to the message being received by the receiving unit. See Response, Remarks dated 03/06/2006, page 15, lines 4-20. It is evident from the detailed mappings found in the above rejection(s) that Geiger et al. disclosed this functionality of a REPO 102 making the decision as to a receiving unit of a GPO (Col 7, lines 5-10) (Col 7, line 65-Col 8, line 10). Further, it is clear from the numerous teachings (previously and currently cited) that the provision for email discrimination, was widely implemented in the networking art. Thus,

Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent no. 6,275,850 by Beyda et al, teaches about a method and system for management of message attachments.

US Patent Application no. 2003/0236840 by HIROOKA, teaches about electronic processing and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael S. A. Delgado whose telephone number is (571) 272-3926. The examiner can normally be reached on 7.30 AM - 5.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn Jr. can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MD



WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER